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PATENT

Attorney Docket File No. 34099/US/2

Dorsey File No. 463077-00267

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

DESJARLAIS et al.

Serial No.: 10/820,465

Filed: March 31, 2004

For: *April Variants and Methods Thereof*

Group Art Unit: 1646

Examiner: To Be Assigned

CERTIFICATE OF MAILING

I hereby certify that this correspondence, including listed enclosures, is being deposited with sufficient postage with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450 on :

Date:

Sept. 10, 2004

Signature:

Carey Peralta

Carey Peralta

RESPONSE TO NOTICE REGARDING BENEFIT/PRIORITY CLAIM(S)

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This communication is in response to Notice Regarding Benefit/Priority Claims mailed on August 18, 2004 regarding a prior-filed nonprovisional application being improperly indicated as a National Stage (35 U.S.C. § 371) Application. Applicants request that the application, PCT International Serial Number PCT/US03/00394, filed on January 6, 2003, claims the benefit of 35 U.S.C § 119(e). Therefore, Applicants are submitting a Supplemental Application Data Sheet to correctly add the PCT International Application in the priority field.

A copy of the preliminary amendment, showing the amended priority reference in the specification is enclosed. The priority reference was amended on July 29, 2004 and therefore was submitted within the four months of the filing date of the application according to 37 C.F.R. 1.78 (a)(2)(ii).

Serial No.: 10/820,465
Filing Date: March 31, 2004

Applicants believe no fee is due and none is enclosed. The Commissioner is authorized to charge any fees, including extension fees or any other relief which may be required, or credit any overpayment to Deposit Account No. 50-2319 (Order No. 34099/US/2 (463077-00267)).

Please direct any calls in connection with this application to the undersigned at (415) 781-1989.

Respectfully submitted,
DORSEY & WHITNEY LLP

Dated: 9/10/04
Dorsey & Whitney LLP
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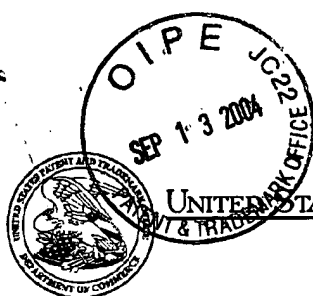
BY: 

Renee M. Kossak, Reg. No. 47,717 for
Robin M. Silva, Reg. No. 38,304

Customer Number: 32940

Attachments:

Copy of Notice Regarding Benefit/Priority Claim(s) dated August 16, 2004
Copy of Supplemental Application Data Sheet submitted on July 29, 2004 marked to show changes
Supplemental Application Data Sheet
Copy of Preliminary Amendment dated July 29, 2004



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|--------------------|------------------------|-------------------------|-------------------------|
| 10/820,465 | 04/02/2004 | John Rudolph Desjarlais | 34099/US/2 463077-00267 |

CONFIRMATION NO. 7263



OC000000013553470

Robin M. Silva, Esq.
 Dorsey & Whitney LLP
 Intellectual Property Department
 Four Embarcadero Center, Suite 3400
 San Francisco, CA 94111-4187

Date Mailed: 08/16/2004

Notice Regarding Benefit/Priority Claim(s)

☐ Improper Benefit Claim(s) to Prior-Filed Nonprovisional Application(s)

The benefit claim(s) to prior-filed nonprovisional application(s) is improper because there is no specific reference for each prior-filed application that includes: (1) the identification of the prior-filed application by application number, or international application number and international filing date; and (2) a clear indication the relationship (i.e., continuation, divisional, or continuation-in-part) of the nonprovisional applications. For example, applicant should amend the specification to include a specific reference, such as "This application is a continuation of Application No. 10/---,--- filed ---." in the first sentence of the specification following the title.

Applicant should review each benefit claim submitted and, if appropriate, provide the proper reference to the prior-filed application(s) as required by 37 CFR 1.78. A proper relationship includes an identification of each nonprovisional application as a continuation, divisional or continuation-in-part application of the immediate prior-filed nonprovisional application for which a benefit is claimed under 37 CFR 1.78 in order to establish copendency throughout the entire chain of prior-filed applications. The specific reference must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

Timeliness: The required reference for each benefit claim must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed. See 37 CFR 1.78(a).

☐ Improper Benefit Claim(s) to Prior-Filed Nonprovisional Application(s)

The benefit claim(s) to prior-filed provisional application(s) is improper because the instant application was not filed within twelve (12) months from the filing date of the provisional application,

and there is no indication of an intermediate nonprovisional application that is directly claiming the benefit of the provisional application and filed within 12 months of the filing date of the provisional application. For example, applicant should amend the specification to include a specific reference, such as "This application is a continuation of Application No. 10/---,--- filed ---, which claims the benefit of U.S. Provisional Application No. 60/---,--- filed---." in the first sentence of the specification following the title.

Applicant should review each benefit claim submitted and, if appropriate, provide the proper reference to the prior-filed applications (including an indication of any intermediate nonprovisional application that is directly claiming the benefit of the provisional application and filed with 12 months of the filing date of the provisional application) as required by 37 CFR 1.78. The required reference must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

Timeliness: The required reference for each benefit claim must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed during the pendency of the instant application.

☐ **Improper Priority Claim(s) to Prior-Filed Foreign Application(s)**

The instant application was not filed within twelve (12) months from the filing date of the prior-filed foreign application, and there is no benefit claim to an intermediate nonprovisional application filed within 12 months of the filing date of the foreign application. Applicant should review each priority claim submitted and, if appropriate, provide the proper reference to any intermediate nonprovisional application filed within 12 months of the filing date of the foreign application in compliance with 37 CFR 1.78, or delete the priority claim. The required reference to an intermediate nonprovisional application must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

Timeliness: The required reference for the benefit claim to an intermediate nonprovisional application must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed.

☐ **Benefit Claims to More Than 400 Prior-Filed Applications**

The Office's automated system to record and capture benefit claims is only capable of recording benefit claims for 400 prior-filed applications. Therefore, the Office is unable to generate a filing receipt containing benefit claims for more than 400 prior-filed applications even though applicant is entitled to submit benefit claims for more than 400 prior-filed applications. Accordingly, applicant should not request a corrected filing receipt to include benefit claims for more than 400 prior-filed applications.



Prior-Filed Nonprovisional Application has been Improperly Indicated as a National Stage (35

U.S.C. 371) Application

Applicant submitted a benefit claim to a prior-filed nonprovisional application and improperly indicated that the prior-filed application is a national stage application under 35 U.S.C. 371. The Office's records show that the prior-filed application is an application filed under 35 U.S.C. 111(a). The Office has entered the benefit claim to the prior-filed application as a benefit claim to an application filed under 35 U.S.C. 111(a). Any request for a corrected filing receipt to include the indication that the prior-filed application is a national stage application will not be granted unless applicant supplies evidence that the prior application was in fact a national stage application. Accordingly, applicant should not submit such request without such evidence. Applicant should submit an amendment (or an application data sheet (ADS) if the benefit claim was submitted in an ADS) to delete the indication that the prior-filed application is a national stage application. *PCT/US/03/00394*

For more information and examples on benefit claims, please see Claiming the Benefit of a Prior-Filed Application under 35 U.S.C. 119(e), 120, 121, and 365(c), 1268 Off. Gaz. Pat. Office 89 (March 18, 2003), which is available on the USPTO website at <http://www.uspto.gov/web/offices/com/sol/og/2003/week11/patbene.htm>, and the Manual of Patent Examining Procedure (MPEP) §§ 201.11 and 201.14.

PART 2 - COPY TO BE RETURNED WITH RESPONSE